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IN THE

# Supreme Court of the United States

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October Term, 1938.

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No. 441.

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THE ELECTRIC STORAGE BATTERY COMPANY,

*Petitioner.*

v.

GENZO SHIMADZU and NORTHEASTERN  
ENGINEERING CORPORATION,

*Respondents.*

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## REPLY BRIEF FOR PETITIONER.

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**REPLY BRIEF FOR PETITIONER.**

**Point I.**

Save as provided in R. S. 4887, an invention made abroad does not come within the contemplation or cognizance of the patent statutes of the United States unless and until it has been patented or described in a printed publication here or abroad, or the invention has been communicated and described to some person or persons in this country.

Respondents have entirely misapprehended petitioner's Point I.

Respondents say (their brief p. 10) that

"the precise question for the determination of this court is whether the phrase 'in this country' should be read into R. S. 4886 immediately following the words 'before his invention or discovery thereof' (both occurrences) *to limit the time and place of invention or discovery.*"\*

Respondents are wrong.

Petitioner, of course, makes no contention that aliens may not obtain United States patents or that inventions

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\* Italicized matter throughout this brief is counsel's.



made abroad may not be here patented if the statutory conditions pertaining thereto are met.

What petitioner does say is that the originator, in this country, of a process and apparatus here known and used is no less an inventor than one who independently produces abroad the same process and apparatus. If either is an inventor, both are.

As between two such inventors, one of whom makes the invention here and the other makes the same invention abroad, R. S. 4886 makes the American invention the "new" and novel one, if, at the time the invention was made in this country, the foreign invention, although made first, had not been patented, described in a printed publication, bought within the purview of R. S. 4887, or communicated to any person in this country.

The statute R. S. 4886, likewise confers upon the inventor who thus made the invention in this country the rank of "first inventor".

These consequences flow from the statute, R. S. 4886, in that the words thereof, "not known or used by others *in this country*", require that unpatented and unpublished foreign inventions which have not been brought within the purview of R. S. 4887, or actually disclosed to some one in this country, are to be disregarded in determining the novelty of the invention here made. The status of the quality of novelty which attached to the invention made in this country and the rank of "first inventor", to which the inventor in this country became entitled at the time of his invention, cannot be destroyed or adversely affected by the subsequent importation in any manner into this country of the invention previously made abroad which was unpatented and unpublished at the time the invention was made in this country.

These results of the statute, R. S. 4886, are precisely the same, regardless of whether the inventor of the invention made in this country does or does not apply for or obtain a patent for his invention.

Consequently, knowledge and use in this country invalidates a patent granted for the same invention made abroad if at the time the invention (evinced by the knowledge and use in this country) was made in this country, the foreign invention, though theretofore made, was unpatented and unpublished and had not been brought within the purview of R. S. 4887 or communicated and disclosed to some person or persons in this country.

The Amendment of 1903 to R. S. 4887 merely provides an exception, in favor of those making inventions abroad, to the foregoing broad, general rule of R. S. 4886. The exception so created by the Amendment to R. S. 4887 "must be found within the four corners" of that Amendment. Indeed, if R. S. 4886 gave to inventions made abroad and their inventors equal rights of novelty and priority with inventions made in this country and the inventors thereof, the Amendment of 1903 to R. S. 4887 would serve no useful purpose.

Respondents' failure to appreciate the precise question here presented by petitioner results in part, perhaps, from respondents' erroneous assumption (pages 8, 9 of their brief) that petitioner's contention is based primarily, if not entirely, upon R. S. 4923, and not at all upon R. S. 4886.<sup>1</sup>

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<sup>1</sup> R. S. 4923 provides that a patent, granted under the conditions there specified, "*shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication.*" [*Footnote continued on following page.*]

Under the first patent statute a "new" invention, as defined by the Congress, was one "not before known or used," thus making it essential that the invention be "new" to all the world.<sup>2</sup> By reason, however, of the inclusion of the words "in this country" in Sec. 24 of the Consolidated Patent Act of 1870 (16 Stat. 198) after the words "not known or used by others," knowledge or use of any unpatented and unpublished invention in a foreign country was deprived of its anticipatory effect.<sup>3</sup>

The amendment of 1870 is still in force as part of R. S. 4886. Under the concurrent findings of the courts below, petitioner was using commercially in June, 1921, in this country, at Philadelphia, a process and apparatus the same as, or substantially like, the inventions of the claims here in suit but which foreign inventions, in June, 1921, had not been patented, published, brought within the purview of R. S. 4887 or actually brought into this country.

If the subject matter of the claims here in suit constitutes patentable subject matter, so the like process and apparatus used commercially in Philadelphia in June, 1921, constitute like patentable subject matter.<sup>4</sup>

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R. S. 4886 as it existed at the time of the grant of the patents here in suit and now exists, provided in effect that no person, otherwise entitled thereto, should be debarred from receiving a patent for his invention or discovery, because of prior knowledge or use thereof abroad, if the invention abroad had not been patented or described in a printed publication prior to the invention or discovery sought to be patented.

<sup>2</sup> *Sewell v. Jones*, 91 U. S. 171, 179-180; *Pennock v. Dialogue*, 2 Pet. 20, 22; *Dawson v. Follen*, Fed. Case 3670.

<sup>3</sup> *Hurlbut v. Schillinger*, 130 U. S. 456, 471; *Permutit v. Wadham*, 13 Fed. (2d) 454, 456; *Doyle v. Spaulding*, 19 Fed. 744.

<sup>4</sup> The inescapable result of the concurrent findings of the courts below that petitioner was using in June 1921

But the importation into this country after June, 1921, of the unpatented and unpublished inventions theretofore made in Japan did not affect the novelty of the process and apparatus here present and commercially used prior to such importation or deny to the inventor of petitioner's process and apparatus the rights or status of first inventor which prior to such importation, he had.

If the importation of such foreign inventions were permitted to bring about a transfer of novelty from the inventions being used in Philadelphia and a transfer of the rank of first inventor from the inventor thereof to the subsequently imported unpatented and unpublished inventions made abroad and the inventor thereof, the amendment of 1870 would be nullified and R. S. 4886 would be given the status and effect of the Patent Act of 1790.

The manifest result is that, as against knowledge and use of inventions in this country, prior to the importation into this country of the same or substantially the same inventions independently made abroad, the Patent Statutes of the United States proscribe all evidence of such foreign inventions, save that derived from patents, printed publications, or foreign applications within the purview of R. S. 4887.

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the inventions of the claims of the patents here in suit, which were held valid and infringed, is that the process and apparatus so used in Philadelphia in 1921 were as much the result of inventive acts as were the process and apparatus claimed in Shimadzu's patents. Under the doctrine enunciated in *Milburn Co. v. Davis etc. Co.*, 270 U. S. 390, 401, it is, of course not necessary to show who did make the inventions in use by petitioner in June 1921 to show that Shimadzu did not. Their existence here prior to the importation of his unpatented and unpublished inventions denies to his inventions the quality of novelty, and denies to him the status of "first inventor".

*Respondents' brief, page 20.*

The last sentence of R. S. 4887 is but a limitation upon the rights of priority to which a foreign *application* for a patent may give rise.

*Respondents' brief, page 21.*

Walker on Patents, 6th Ed., Sec. 190, says:

“If an invention was fully described in a caveat, then that caveat would constitute evidence showing that invention to have been made at least as early as the caveat was filed.”

To the extent that a foreign invention was described in a caveat, that invention was thereby brought to this country and within the operation of the Patent Statutes.

*Respondents' brief, page 23.*

The Hall patents are not here in issue. Petitioner is here claiming no rights thereunder. Had Hall been denied a patent by the Court of Customs and Patent Appeals, petitioner would not in this case have been affected thereby; for R. S. 4914, 35 U. S. C. Sec. 62, provides:

“But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the *validity* of such patent in any court wherein the same may be called in question.”

*Respondents' brief, page 24.*

The “other proceedings” referred to in section 6 of the Nolan Act, 35 U. S. C., Sec. 85, are not limited to proceedings under R. S. 4915 and R. S. 4918. “Proceeding” is a word of broad import. It includes

"The instituting or carrying on of an action at law; a legal action or process; any act done by authority of a court of law; any step taken in a cause by either party." Oxford Dictionary.

*Respondents' brief, page 25.*

Respondents there say:

"Before the Amendment of 1903, the written description in a foreign application was evidence of a conception, being a written disclosure of the invention."

Respondents cite no case supporting that statement. Petitioner has found none. Indeed it is directly in conflict with *Wilson v. Sherts*, 81 Fed. (2d) 755 (petitioner's main brief, pp. 18, 19), and like cases.

*Respondents' brief, page 26.*

Here again respondents assert that the only possible limitation upon the right of a foreign inventor to have the benefit of the actual date of his invention abroad is R. S. 4923.

As against knowledge and use in this country of the same or substantially the same invention prior to the importation into this country of an unpatented and unpublished invention made abroad, R. S. 4886 constitutes a complete bar to any claim of the inventor of such foreign invention to the benefits of the date of his invention abroad. The prior user of the same invention here, or the person through whom he claims, is, under R. S. 4886, no less an inventor than he who made the invention abroad. This is equally true whether the thing here used, prior to the importation of the unpatented and unpublished foreign in-



vention, was or was not patented. (Petitioner's main Brief, p. 25).

*Respondents' brief, page 28.*

Respondents here say:

"Hall and petitioner are estopped from claiming Shimadzu's patent rights by reason of the amendment filed in the Patent Office by Hall accepting limited claims in the Hall patents."

Respondents' statement is misleading. Petitioner is not claiming Shimadzu's patent rights. Petitioner denies that Shimadzu has any valid patent rights. That which Petitioner does contend is that any rights to practice the inventions of the process and apparatus claims of the patents here in suit were, long prior to any date to which Shimadzu is entitled as his date of invention under the Statutes, known to and used by some member or members of the American public and, hence, vested in the American public.

The Hall patents are found in R. III, pages 37 and 41. They are referred to in a footnote on page 32 of petitioner's main brief. They are without pertinency to the issues presented to this court. The question here raised is whether Shimadzu's patents are valid. R. S. 4914, 35 U. S. C. Sec. 62 deals with the determination of appeals from the Patent Office by the court having jurisdiction to hear such appeals. The last sentence of that section says:

"But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called into question."

*Respondents' brief, page 29.*

Here respondents refer to the express statutory provision with respect to foreign patents and publications.

Shimadzu's inventions, however, were not patented or described in any printed publication in this or any foreign country until long after June, 1921.

*Respondents' brief, pages 29-31.*

Respondents here indicate that a reversal of the decrees below would bar the grant of United States letters patent for any invention made abroad. Manifestly, such is not the case. The conditions under which valid patents for foreign inventions have been and may be granted are those set out in the statutes and summarized in *Wilson v. Sherts*, 81 Fed. (2d) 755. Indeed, according to the figures cited by respondents (footnote, page 31), 4900 such patents were granted during the year 1937. Yet the Patent Office construction of the Patent Statutes, under which those patents were granted, is precisely the construction thereof for which petitioner here contends. (Petitioner's main Brief, pp. 17-19.)

*Respondents' brief, pages 34-37.*

*Opinion in Hanifen v. Godshalk*, 78 Fed. 811.

The deletions made in R. S. 4886 when there quoted by the court are a demonstration that the court in that case did not have brought to its attention the interpolation of the words "in this country" in what is now R. S. 4886, by Sec. 24 of the Consolidated Patent Act of 1870 (16 Stat. 198), or the legal consequences thereof. The court there apparently based its conclusion upon R. S. 4923 only, which provides that a patent shall not be held void because of unpatented and unpublished prior knowledge or use in a foreign country.

The court likewise apparently failed to observe that the issue of priority "in any action for infringement" under



paragraph 4th of R. S. 4920, is the identical issue in interference proceedings in the Patent Office under R. S. 4904.

Again, the court assumed that which was to be proved: namely, that the defendant was "an infringer" instead of a member of the American public who was entitled to rely in support of his defence of invalidity of the patent there in suit, on the patents granted prior to the importation into this country of the then unpatented and unpublished foreign invention.

#### **Point II.**

**If Shimadzu's acts in Japan are within the cognizance of the patent statutes of the United States, he suppressed, concealed and withheld his inventions until long after petitioner had brought into commercial use in this country inventions similar to or identical with his.**

(1) Respondents (their brief, p. 39) rely upon *Rubber Co. v. Goodyear*, 76 U. S. 788, 801, to sustain their contention that the defense that Shimadzu suppressed his inventions, may not be here availed of in that it was not set up in the answer. The Goodyear case does not so hold. The defense there pleaded was that the patented articles had not been marked "patented" in conformity with R. S. 4900.

That fact was available for pleading long prior to the trial of the case. In the case at bar, petitioner contended and believed that the inventions of the patents in suit had been claimed and patented in Japanese patents 41,728 and 42,563 (R. III, pp. 30-33), and contended that the patents in suit were invalid because those Japanese patents issued prior to the patents in suit and the applications therefor were not filed within twelve months prior to the filing of the applications in this country for the patents in suit. The courts below denied this defense of petitioner, held that

these Japanese patents were not for the same invention as the patents in suit, and that the date of Shimadzu's "invention" and "*successful reduction to practice*," in Japan was not later than August, 1919. (R. II, p. 1166).

The courts below likewise held (R. II, p. 1172):

"We are not concerned with the motives which prompted him, in taking out the '563 patent, to confine it to the single step of mechanical removal of the dust from the drum, and to *withhold* the really essential steps of the invention for later patenting. It is sufficient to say that he had the right to do this if he chose."

That the patents in suit are invalid (if Shimadzu's acts in Japan are within the cognizance of the patent statutes of the United States) because Shimadzu suppressed, concealed and withheld his inventions for years after he had reduced them to actual practice in Japan, became apparent only after and because of the conclusions of the courts below, i. e., that Shimadzu is entitled to rely upon the date of his invention and reduction to practice in Japan, and that Japanese patents 41,728 and 42,563 are not for the same inventions as the patents in suit. A defense so arising seems analogous to the defenses in *Slawson v. Grand Street R. R. Co.*, 107 U. S. 649, *Dunbar v. Myers*, 94 U. S. 187, and *Brown et al. v. Piper*, 91 U. S. 37, 44. Indeed, in those cases the bill was dismissed because the inventions described in the patents were not patentable, although no such defense was set up in the answer. Here the invalidity of the patents in suit appears from the face of the opinions below, when measured by the rule of law laid down in *Kendall v. Winsor*, 21 How. 322. A decree of validity in the face of findings showing invalidity would be as incongruous and inequitable as a decree of validity when invalidity appears from the face of the patent.

(2) In their paragraph (2) of Point II, beginning on page 39 of their brief, respondents attempt to excuse Shimadzu's withholding his inventions, first on the ground that he was installing new mills and engaging in further experiments in the perfection of his invention, and second because there were no intervening rights between the date of the inventions in August 1919 and the filing of the applications for the patents here in suit.

To the first of these contentions of respondents, it is a sufficient answer that both courts below found (R. II, 1166, 1178) that in August 1919 Shimadzu had not only a conception of his inventions, but as well a "successful reduction to practice" in Japan. Under such facts the doctrine of *Elizabeth v. Paving Co.*, 97 U. S. 126, touching further experiments, is without application.

With respect to respondents' second contention with regard to rights intervening between August 1919, and the filing of the applications for the three patents here in issue, respondents seek to give some value and pertinency to Shimadzu's application of December 1920 (PX39). It has none. In that application Shimadzu said:

"I pulverize metallic lead by mechanical means into fine powder."

The powder so obtained was then oxidized. As stated by the Examiner in his communication of October 20, 1921:

"... the method employed in obtaining the lead in the finely divided condition used, is not given."

On July 18, 1922, more than twelve months after the commercial use of petitioner's process and apparatus in Philadelphia in June 1921, Shimadzu attempted to cure that defect by amendments. In a communication from the

Examiner to Shimadzu's solicitors, dated May 17, 1923, the Examiner stated:

"The amendment to page 2 regarding the pulverizing of the lead is considered to involve new matter and should be canceled."

Respondents here state (their brief, page 40):

"Obviously in view of all the testimony of record the 'mechanical means' referred to (in the application of December 1920) is the rotating drum used by Shimadzu in 1919 . . ."

But the disclosure of the application cannot be now so amended. Consequently, the application of December 1920 and the attempted amendment thereof in July 1922 are without the remotest pertinency to the issues here. Respondents did not and do not even attempt to point to common subject matter between that application and the claims here in issue. They merely assert that the patents here in suit were granted on "continuation applications" based upon the application of December 1920. In order to establish, respondents refer to *General Pictures Co. v. Electric Co.*, 304 U. S. 175, 183, and quote therefrom as follows:

"The effective dates of the claims of the continuation applications are those of the original applications."

Respondents fail to quote from the opinion in that case the statement of that which alone makes a later co-pending application a continuation application to an earlier one. That statement, p. 183, is,

"The subjects matter of the claims of the other two patents were disclosed in the original applications and were claimed in the continuation application upon which they issued."

The application of December 1920 did *not* disclose the subject matter of any of the claims here in issue. As a consequence, none of the claims here in issue can have an effective date earlier than that of the respective applications for the patents here in issue containing such claims.

On pages 42-43 of their brief, respondents cite *Kendall v. Winsor*, 21 How. 322, 328, to establish that an inventor is entitled to "a delay requisite for completing an invention, . . .".

This, too, ignores the fact that both courts below found that the inventions of the patents here in suit had been *reduced to practice* in August 1919 and the further fact that Shimadzu himself testified (R. II, 1140) that from June 1920 he was "producing at the same time for commercial purposes."

Yet, Shimadzu continued "to *withhold* (R. II, 1172) the really essential steps of the invention" from the American public for years thereafter and until long after like inventions were brought into commercial use by petitioner in Philadelphia in June 1921.

Respondents' arguments on these points leave them on the horns of a dilemma. Either Shimadzu did not have the inventions of the claims here in issue until about the time he filed his applications for the patents containing them, or if he did, he withheld, suppressed, and concealed them from the American public until long after some member or members of the American public had here made the inventions and brought them into commercial use. In neither case are the patents in suit valid.

Point III.

Petitioner's commercial use in June 1921 of its Hardinge Mill and process was, in law, a public use. Such use was more than two years prior to Shimadzu's application for his patents 1,584,150 and 1,896,020.

The courts below did not find that there was not any public use by petitioner in June 1921 of the inventions called for by the claims here in issue.

On the contrary, both courts below found (R. II, 1192):

"It is therefore plain that there is no evidence of anything beyond an *experimental* use by the defendant earlier than about the middle of the year 1921 . . . .

"*Commercial production* (by petitioner) by the Hardinge Mill with its forced air draft undoubtedly involved the use of plaintiff's patent, and June 1921 may be fixed as the date when that began."

The finding of "commercial production" by petitioner in June 1921 was in contrast with the "experimental use" of the inventions in the early part of the year 1921.

Moreover, the finding of "commercial production" in June 1921 was made by the trial court after a rehearing at the instance of respondents. A special memorandum with respect thereto was filed by the trial court (R. II, 1189-1192). The implication of this memorandum would seem to be that the trial court intended to find, by "commercial production" in June 1921 as distinguished from January 1921, a public use. True, the trial court did not expressly so state. But certainly it did find "commercial production", as distinguished from "experimental use", in June 1921.

Yet, respondents state in their brief, page 52, that



" . . . petitioner has shown no production for the year 1921 . . . ."

Respondents in making this statement, have overlooked the direct oral and documentary evidence to the contrary. Indeed, the finding of the court was dictated by uncontradicted oral and documentary evidence (R. I, 463). Log sheets typified by those of June 14, 1921 (DX60) show that petitioner then produced 1,500 pounds of gray oxide per eight hour shift. They also show regular written determinations, four or five per shift, of specific gravity and oxidation, demonstrating complete control of the process (DX48-58).

The lead dust so produced was used to make battery plates (R. I, 465).

One Cooper, who went to work for petitioner in June 1923 and left sometime in 1930 (R. I, 401), was respondents' voluntary witness with respect to the process and apparatus used by petitioner during that time. As shown by the evidence (R. I, 460-466) and by the findings of the courts below (R. II, 1175), the process and apparatus then employed were the same as those employed by petitioner in June of 1921. Petitioner's process and apparatus were likewise explained to respondents by one Nagle, also a former employee of petitioner (R. I, 420, 423). The record does not show the period of his employment.

Under such circumstances respondents are manifestly estopped from asserting that petitioner's use of its process and apparatus was secret during the time of Cooper's employment. But it is believed that that estoppel includes not only the time of Cooper's employment, but *all* the time during which the process and apparatus have been used by petitioner. That a previously existing state of things is presumed to continue to exist has been well established.

*McKelvey's Handbook of the Law of Evidence*, Third Edition, page 128, says:

"subsequent facts are frequently relied upon to prove a previously existing state of facts."

*Wigmore on Evidence*, Vol. I, Sec. 382, says:

"It has already been seen (ante Sec. 190) that the prior or the subsequent existence of a quality or condition is evidence of its existence at a given time . . . . Such evidence is receivable to show the mode of conducting a business . . . and so on."

Moreover, in *Twyman v. Radiant Glass Co.*, 56 Fed. (2) 119, the Circuit Court of Appeals for the Eighth Circuit held that the use of an alleged infringing mold in which glass cylinders were made was a public use, upon the ground that the glass cylinders there made were produced for commercial purposes.

The ruling of this Court in *Egbert v. Lippmann*, 104 U. S. 333, is summarized in the second paragraph of the syllabus thus:

"There may be a public use of the invention although but a single machine or device for which the Letters were subsequently granted, was used only by one person."

In *Brush v. Condit*, 132 U. S. 39, 49, this Court, quoting from its opinion in *Hall v. Macneale*, 107 U. S. 90, 97, said:

"The construction and arrangement and purpose and mode of operation and use of the bolts in the safes were necessarily known to the workmen who put them in. They were, it is true, hidden from view, after the safes were completed, and it required a destruction of the safes to bring them into view. But this was no concealment of them or use of them in secret."



The same statement could be made in substance with respect to petitioner's use of its process and apparatus in June, 1921 and thereafter.

*Respondents' brief, pages 56-58:*

On page 56 of their brief, respondents say:

"Petitioner's uses were clearly experimental from June, 1921, on until the end of that year and in fact until 1923, when standardized machines were bought."

That statement is in direct conflict with the concurrent findings of the courts below. It is likewise in direct conflict with the evidence, both oral and documentary. (R. I., 460-468 and exhibits there referred to.)

The statements of respondents on pages 56-58 of their brief, that petitioner's uses were experimental from June 1921 until 1923, are most inept.

If the matters there asserted to evince an experimental state and to negative complete invention, have that effect, then respondents have established completely that the patents here in suit are wanting in invention; for those patents make no disclosures of the facts which respondents, on pages 56-58 of their brief, would make indispensable to the existence of the invention.

Indeed, Shimadzu's patents here in suit show to the point of demonstration that Shimadzu had not arrived, even at the time he filed his several applications for these patents, to that state of knowledge in lead dust manufacture, which petitioner had attained as early as July 24, 1917. DX78 (R. III, 26-29) is a report made in July 1917 by Mr. Kershaw, an employee of petitioner, of the processes employed and the results obtained by petitioner's operation of its so-called Tudor Mill which was a duplicate or reproduction of mills

long theretofore in use in Germany for the manufacture of lead dust. (R. I, 539.)

Patents 1,584,150 and 1,896,020 are, therefore, invalid also because of two years public use of the alleged inventions thereof before the applications therefor were filed (R. S. 4886, and 4887).

**CONCLUSION.**

Under the concurrent findings of the courts below, the claims of Patents Nos. 1,584,149, 1,584,150 and 1,896,020, here in suit are invalid.

Respectfully submitted

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February 7, 1939.



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